



S/N 09/773,971

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | | | |
|-------------|---|-----------------|-------------------------|
| Applicant: | Eric G. Lang | Examiner: | Vu, Thanh T. |
| Serial No.: | 09/773,971 | Group Art Unit: | 2174 |
| Filed: | January 31, 2001 | Docket No.: | MS150411.1/40062.86US01 |
| Title: | OVERLAID DISPLAY FOR ELECTRONIC DEVICES | | |

DECLARATION UNDER 37 CFR §1.131

I, Ido Tuchman, declare as follows:

1. I am the attorney that drafted and filed U.S. Patent Application Serial No. 09/773,971, filed January 31, 2001 ("the '971 application"). Although I no longer work at Merchant & Gould, I am providing the current Rule 131 Declaration because I am the person most knowledgeable of the events surrounding the filing of the '971 application.

2. I am aware that a currently pending Office Action was mailed in this application on March 25, 2005, and that all the pending claims were rejected as being obvious under 35 USC § 103(a) in view of a combination of references, including published application 2002/0024505 (hereinafter, "the published application"). The published application was filed on January 19, 2001, a mere 12 days prior to the filing date of the '971 application.

3. The '971 application was finalized in early January 2001, and the inventor, Eric Lang, signed the Declaration for the '971 application on January 12, 2001. See Exhibit A, attached hereto (copy of declaration of Eric Lang). The signed "formal papers" (including the declaration) were then sent by overnight delivery to the law firm of Merchant & Gould. See Exhibit B (email correspondence from client indicating overnight shipment of the "formal papers").

4. Although my normal practice would be file a patent application immediately after receiving the signed "formal papers" from the client, in this instance the client (Microsoft) requested that we attempt to electronically file the '971 application (along with a related application). Indeed, these two related applications were to serve as "test cases" for utilizing the newly-implemented electronic filing procedures at the U.S.

Patent and Trademark Office. Unfortunately, we experienced numerous problems when trying to electronically file these two “test cases,” and these difficulties (characterized as software “bugs”) were reported to the client in an email dated January 19, 2001 (attached hereto as Exhibit C).

5. In particular, the email correspondence in Exhibit C was sent to notify the client of a delay in filing the ‘971 application (caused by the unsuccessful attempts to file the ‘971 application electronically), and requests instruction from the client regarding whether the electronic filing efforts should be abandoned for a more conventional filing process (i.e., Express Mail). In a reply email also dated January 19, 2001 (attached as Exhibit D), the client representative (Joe Hoggard) instructed me to continue with our efforts to file electronically, but also noted that the application should be filed conventionally by the end of the month if the software bugs could not be overcome. I discussed this situation in a telephone conference with Mr. Hoggard and then sent a confirmation email on January 25, 2001 (also included in Exhibit D), stating that we would continue our efforts to file electronically until January 30, 2001, and would then file the application conventionally if we were not successful. Ultimately, we were not successful in our electronic-filing efforts, and thus I filed the ‘971 application by Express Mail on January 31, 2001. See Exhibit E (copy of transmittal letter signed by me on January 31, 2001).

6. In light of the above facts, it is apparent that the invention of the ‘971 application was “conceived” at least by the date the inventor signed the declaration (i.e., January 12, 2001). This date is prior to the filing date of the published application cited in the pending Office action. Additionally, diligent efforts were made for several weeks to file the application electronically, and these efforts began prior to the January 19, 2001, filing date of the published application (see Exhibit C). Furthermore, these efforts continued until the ultimate filing of the ‘971 application on January 31, 2001 (see Exhibit D).

7. Thus, the above facts, corroborated by the attached exhibits, detail that the invention of the ‘971 application was conceived prior to the filing date of the cited reference (i.e., by at least the date that the declaration was signed, as shown in Exhibit A, although the invention was obviously conceived at a much earlier date). Furthermore,

although a gap of approximately three weeks extends between the date the declaration was signed and the date the application was actually filed, this gap is explained by the diligent efforts on the part of Merchant & Gould to electronically file this "test case." Thus, the invention of the '971 application was clearly conceived prior to the critical date of the cited application, and diligent efforts were continuously made to (constructively) reduce the invention to practice from a point prior to the filing date of the cited application (i.e., January 19, 2001) up to the date the application was ultimately filed on January 31, 2001.

8. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such false statements may jeopardize the validity of the application or any patent issued thereon.

Date

6/7/05

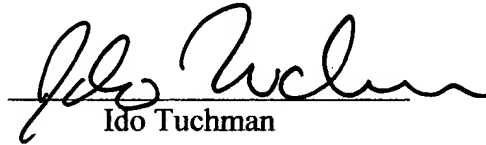

Ido Tuchman

EXHIBIT A



MS #150411.1/40062.0086US01

MERCHANT & GOULD P.C.

United States Patent Application

COMBINED DECLARATION AND POWER OF ATTORNEY

As a below named inventor I hereby declare that my residence, post office address and citizenship are as stated below next to my name; that

I verily believe I am the original, first and sole inventor (if only one name is listed below) or a joint inventor (if plural inventors are named below) of the subject matter which is claimed and for which a patent is sought on the invention entitled "OVERLAID DISPLAY FOR ELECTRONIC DEVICES," the specification of which I have reviewed and for which I solicit a United States patent hereto.

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims.

I acknowledge the duty to disclose information which is material to the patentability of this application in accordance with Title 37, Code of Federal Regulations, § 1.56 (attached hereto).

I hereby claim foreign priority benefits under Title 35, United States Code, § 119/365 of any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on the basis of which priority is claimed:

- a. ☒ no such applications have been filed.
b. ☐ such applications have been filed as follows:

| FOREIGN APPLICATION(S), IF ANY, CLAIMING PRIORITY UNDER 35 USC § 119 | | | |
|--|--------------------|--------------------------------------|-------------------------------------|
| COUNTRY | APPLICATION NUMBER | DATE OF FILING (day, month, year) | DATE OF ISSUE (day, month, year) |
| | | | |

| ALL FOREIGN APPLICATION(S), IF ANY, FILED BEFORE THE PRIORITY APPLICATION(S) | | | |
|--|--------------------|--------------------------------------|-------------------------------------|
| COUNTRY | APPLICATION NUMBER | DATE OF FILING (day, month, year) | DATE OF ISSUE (day, month, year) |
| | | | |

I hereby claim the benefit under Title 35, United States Code, § 120/365 of any United States and PCT international application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code, § 112, I acknowledge the duty to disclose material information as defined in Title 37, Code of Federal Regulations, § 1.56(a) which occurred between the filing date of the prior application and the national or PCT international filing date of this application.

| U.S. APPLICATION NUMBER | DATE OF FILING (day, month, year) | STATUS (patented, pending, abandoned) |
|-------------------------|-----------------------------------|---------------------------------------|
| | | |

I hereby claim the benefit under Title 35, United States Code § 119(e) of any United States provisional application(s) listed below:

| U.S. PROVISIONAL APPLICATION NUMBER | DATE OF FILING (Day, Month, Year) |
|-------------------------------------|-----------------------------------|
| | |

I hereby appoint the following attorney(s) and/or patent agent(s) to prosecute this application and to transact all business in the Patent and Trademark Office connected herewith:

Albrecht, John W.

Reg. No. 40,481

Lacy, Paul E.

Reg. No. 38,946

| | | | |
|-----------------------------|------------------|---------------------------|-------------------|
| Ali, Jeffer M. | Reg. No. 5,359 | Larson, James A. | Reg. No. 40,443 |
| Anderson, Gregg I. | Reg. No. 28,828 | Liepa, Mara E. | Reg. No. 40,066 |
| Batzli, Brian H. | Reg. No. 32,960 | Lindquist, Timothy A. | Reg. No. 40,701 |
| Beard, John L. | Reg. No. 27,612 | Lycke, Lawrence E. | Reg. No. 38,540 |
| Berns, John M. | Reg. No. 43,496 | McAuley, Steven A. | Reg. No. P-46,084 |
| Black, Bruce E. | Reg. No. 41,622 | McDonald, Daniel W. | Reg. No. 32,044 |
| Branch, John W. | Reg. No. 41,633 | McIntyre, Jr., William F. | Reg. No. P-44,921 |
| Bremer, Dennis C. | Reg. No. 40,528 | Mueller, Douglas P. | Reg. No. 30,300 |
| Bruess, Steven C. | Reg. No. 34,130 | Pauly, Daniel M. | Reg. No. 40,123 |
| Byrne, Linda M. | Reg. No. 32,404 | Phillips, Bryan K. | Reg. No. P46,990 |
| Carlson, Alan G. | Reg. No. 25,959 | Phillips, John B. | Reg. No. 37,206 |
| Caspers, Philip P. | Reg. No. 33,227 | Plunkett, Theodore | Reg. No. 37,209 |
| Chiapetta, James R. | Reg. No. 39,634 | Prendergast, Paul J. | Reg. No. 46,068 |
| Clifford, John A. | Reg. No. 30,247 | Pytel, Melissa J. | Reg. No. 41,512 |
| Daignault, Ronald A. | Reg. No. 25,968 | Qualey, Terry | Reg. No. 25,148 |
| Daley, Dennis R. | Reg. No. 34,994 | Reich, John C. | Reg. No. 37,703 |
| Dalglish, Leslie E. | Reg. No. 40,579 | Reiland, Earl D. | Reg. No. 25,767 |
| Daulton, Julie R. | Reg. No. 36,414 | Schmaltz, David G. | Reg. No. 39,828 |
| Devries Smith, Katherine M. | Reg. No. 42,157 | Schuman, Mark D. | Reg. No. 31,197 |
| DiPietro, Mark J. | Reg. No. 28,707 | Schumann, Michael D. | Reg. No. 30,422 |
| Edell, Robert T. | Reg. No. 20,187 | Scull, Timothy B. | Reg. No. 42,137 |
| Epp Ryan, Sandra | Reg. No. 39,667 | Sebald, Gregory A. | Reg. No. 33,280 |
| Glance, Robert J. | Reg. No. 40,620 | Skoog, Mark T. | Reg. No. 40,178 |
| Goggin, Matthew J. | Reg. No. 44,125 | Spellman, Steven J. | Reg. No. 45,124 |
| Golla, Charles E. | Reg. No. 26,896 | Stoll-DeBell, Kirstin L. | Reg. No. 43,164 |
| Gorman, Alan G. | Reg. No. 38,472 | Sumner, John P. | Reg. No. 29,114 |
| Gould, John D. | Reg. No. 18,223 | Swenson, Erik G. | Reg. No. 45,147 |
| Gregson, Richard | Reg. No. 41,804 | Tellekson, David K. | Reg. No. 32,314 |
| Gresens, John J. | Reg. No. 33,112 | Trembath, Jon R. | Reg. No. 38,344 |
| Hamer, Samuel A. | Reg. No. P46,754 | Tuchman, Ido | Reg. No. 45,924 |
| Hamre, Curtis B. | Reg. No. 29,165 | Underhill, Albert L. | Reg. No. 27,403 |
| Hertzberg, Brett A. | Reg. No. 42,660 | Vandenburgh, J. Derek | Reg. No. 32,179 |
| Hillson, Randall A. | Reg. No. 31,838 | Wahl, John R. | Reg. No. 33,044 |
| Holzer, Jr., Richard J. | Reg. No. 42,668 | Weaver, Karrie G. | Reg. No. 43,245 |
| Johnston, Scott W. | Reg. No. 39,721 | Welter, Paul A. | Reg. No. 20,890 |
| Kadievitch, Natalie D. | Reg. No. 34,196 | Whipps, Brian | Reg. No. 43,261 |
| Karjeker, Shaukat | Reg. No. 34,049 | Wickhem, J. Scot | Reg. No. 41,376 |
| Kastelic, Joseph M. | Reg. No. 37,160 | Williams, Douglas J. | Reg. No. 27,054 |
| Kettelberger, Denise | Reg. No. 33,924 | Witt, Jonelle | Reg. No. 41,980 |
| Keys, Jeramie J. | Reg. No. 42,724 | Wu, Tong | Reg. No. 43,361 |
| Knearl, Homer L. | Reg. No. 21,197 | Xu, Min S. | Reg. No. 39,536 |
| Kowalchyk, Alan W. | Reg. No. 31,535 | Zeuli, Anthony R. | Reg. No. P45,255 |
| Kowalchyk, Katherine M. | Reg. No. 36,848 | | |

In addition, I also hereby appoint the following attorneys to prosecute this application and to transact all business in the U.S. Patent and Trademark Office in connection therewith:

Kate E. Sako, Reg. No. 32,628
Daniel D. Crouse, Reg. No. 32,022

I hereby authorize them to act and rely on instructions from and communicate directly with the person/assignee/attorney/firm/ organization who/which first sends/sent this case to them and by whom/which I hereby declare that I have consented after full disclosure to be represented unless/until I instruct Merchant & Gould P.C. to the contrary.

Please direct all correspondence in this case to Merchant & Gould P.C. at the address indicated below:

Homer L. Knearl
Merchant & Gould P.C.
P.O. Box 2903
Minneapolis, MN 55402-0903
303.357.1633

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

| | | | | |
|----------------------------|-------------------------|---|--|--|
| 201 | Full Name Of Inventor | Family Name LANG | First Given Name ERIC | Second Given Name G. |
| | Residence & Citizenship | City REDMOND | State or Foreign Country WASHINGTON | Country of Citizenship UNITED STATES |
| | Post Office Address | Post Office Address 16423 N. E. 50th WAY | City REDMOND | State & Zip Code/Country WASHINGTON 98052 |
| Signature of Inventor 201: | | | Date: January 12, 2001 | |
| 202 | Full Name Of Inventor | Family Name | First Given Name | Second Given Name |
| | Residence & Citizenship | City | State or Foreign Country | Country of Citizenship |
| | Post Office Address | Post Office Address | City | State & Zip Code/Country |
| Signature of Inventor 202: | | | Date: | |

§ 1.56 Duty to disclose information material to patentability.

(a) A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective patent examination occurs when, at the time an application is being examined, the Office is aware of and evaluates the teachings of all information material to patentability. Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section. The duty to disclose information exists with respect to each pending claim until the claim is canceled or withdrawn from consideration, or the application becomes abandoned. Information material to the patentability of a claim that is canceled or withdrawn from consideration need not be submitted if the information is not material to the patentability of any claim remaining under consideration in the application. There is no duty to submit information which is not material to the patentability of any existing claim. The duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by §§ 1.97(b)-(d) and 1.98. However, no patent will be granted on an application in connection with which fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct. The Office encourages applicants to carefully examine:

(1) prior art cited in search reports of a foreign patent office in a counterpart application, and

(2) the closest information over which individuals associated with the filing or prosecution of a patent application believe any pending claim patentably defines, to make sure that any material information contained therein is disclosed to the Office.

(b) Under this section, information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and

(1) It establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim;

or

(2) It refutes, or is inconsistent with, a position the applicant takes in:

- (i) Opposing an argument of unpatentability relied on by the office, or
- (ii) Asserting an argument of patentability.

A prima facie case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

(c) Individuals associated with the filing or prosecution of a patent application within the meaning of this section are:

- (1) Each inventor named in the application:
- (2) Each attorney or agent who prepares or prosecutes the application; and

(3) Every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application.

(d) Individuals other than the attorney, agent or inventor may comply with this section by disclosing information to the attorney, agent, or inventor.

EXHIBIT B

Domenica Anderson (Kelly Services Inc)



From: Domenica Anderson (Kelly Services Inc)
Sent: Friday, January 12, 2001 1:10 PM
To: 'hknearl@merchant-gould.com'
Cc: Joe Hoggard (LCA)
Subject: Formals sent: (150410/40062.0085US01 & 150411.1/40062.0086US01)

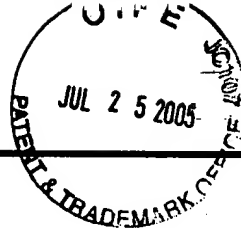
Categories: SPO

Hi,
I am overnighting you the formal papers for the above mentioned cases. Please file them upon receipt.

Thank you,


Domenica Anderson
Patent Group
425.706.5398

EXHIBIT C



Jackie Stewart

From: Ido Tuchman
Sent: Friday, January 19, 2001 1:48 PM
To: 'Joe Hoggard (LCA)'
Cc: Homer Knearl; Betty Terry; Joan Bileau (E-mail); Andy Sanders (E-mail); Jackie Stewart
Subject: MS 150410.1/M&G 40062.0085US01 and MS 150411.1/M&G 40062.0086US01

Hi Joe,

Merchant & Gould is in the process of preparing MS 150410.1 and MS 150411.1 to be filed electronically in accordance with Microsoft's wishes. These two applications will be the first Microsoft applications filed electronically by Merchant & Gould. Currently, we are working out some bugs in the USPTO's software and anticipate filing the applications electronically within the next two weeks, and more likely within a week. There are no potential bar dates for MS 150410.1 and MS 150411.1, but if Microsoft prefers us to file the applications by express mail we can certainly do so. If we don't hear from Microsoft to the contrary, we will continue with our efforts to electronically file MS 150410.1 and MS 150411.1.

Regards,
Ido Tuchman

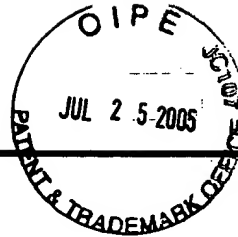
Merchant & Gould P.C.
1050 17th St., Suite 1400
Denver, CO 80265
303.357-1657
303.357-1671 fax

=====
Privileged & Confidential

This message may contain attorney-client communications or attorney work product. If you have received this message in error, please immediately delete it. Please contact Ido Tuchman at the above numbers.

EXHIBIT D

Jackie Stewart



From: Ido Tuchman
Sent: Thursday, January 25, 2001 3:52 PM
To: 'Joe Hoggard (LCA)'
Cc: Homer Knearl; Betty Terry; Joan Bileau (LCA); Andrew Sanders (LCA); Jackie Stewart; Domenica Anderson (Kelly Services Inc); Tamara Blaschko
Subject: RE: MS 150410.1/M&G 40062.0085US01 and MS 150411.1/M&G 40062.0086 US01

Joe,
Pursuant to our telephone conversation, we will continue with our efforts to file the above files electronically until Tuesday, January 30. If we still can not get the applications filed electronically by Tuesday, we will file them via Express Mail.
Best regards,
Ido Tuchman

-----Original Message-----

From: Joe Hoggard (LCA) [mailto:jhoggard@microsoft.com]
Sent: Friday, January 19, 2001 2:42 PM
To: 'Ido Tuchman'
Cc: Homer Knearl; Betty Terry; Joan Bileau (LCA); Andrew Sanders (LCA); Jackie Stewart; Domenica Anderson (Kelly Services Inc)
Subject: RE: MS 150410.1/M&G 40062.0085US01 and MS 150411.1/M&G 40062.0086 US01

Ok. I didn't realize those two had not been filed, but you are correct that there is no bar date. Please send your filing summary promptly after you have successfully filed with the PTO. If it takes longer than a week to work out the bugs in the software, please do not hold it up any further and file the traditional way via express mail. We want them to be filed this month.

Thanks,
Joe

-----Original Message-----

From: Ido Tuchman [mailto:ituchman@merchant-gould.com]
Sent: Friday, January 19, 2001 12:48 PM
To: Joe Hoggard (LCA)
Cc: Homer Knearl; Betty Terry; Joan Bileau (LCA); Andrew Sanders (LCA); Jackie Stewart
Subject: MS 150410.1/M&G 40062.0085US01 and MS 150411.1/M&G 40062.0086US01

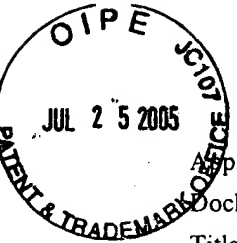
Hi Joe,

Merchant & Gould is in the process of preparing MS 150410.1 and MS 150411.1 to be filed electronically in accordance with Microsoft's wishes. These two applications will be the first Microsoft applications filed electronically by Merchant & Gould. Currently, we are working out some bugs in the USPTO's software and anticipate filing the applications electronically within the next two weeks, and more likely within a week. There are no potential bar dates for MS 150410.1 and MS 150411.1, but if Microsoft prefers us to file the applications by express mail we can certainly do so. If we don't hear from Microsoft to the contrary, we will continue with our efforts to electronically file MS 150410.1 and MS 150411.1.

Regards,
Ido Tuchman

Merchant & Gould P.C.
1050 17th St., Suite 1400
Denver, CO 80265
303.357-1657
303.357-1671 fax

EXHIBIT E



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Eric G. Lang
Docket: MS#150411.1/40062.86US01
Title: OVERLAID DISPLAY FOR ELECTRONIC DEVICES

CERTIFICATE UNDER 37 CFR 1.10

'Express Mail' mailing label number: EL661402772US

Date of Deposit: January 31, 2001

I hereby certify that this paper or fee is being deposited with the United States Postal Service 'Express Mail Post Office To Addressee' service under 37 CFR 1.10 and is addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

By: 
Name: Jackie Stewart

BOX PATENT APPLICATION
Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

We are transmitting herewith the attached:

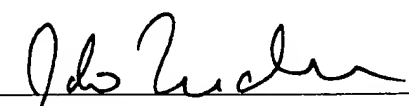
- ☒ Transmittal sheet, in duplicate, containing Certificate under 37 CFR 1.10.
- ☒ Utility Patent Application: Spec. 29 pgs; 32 claims; Abstract 1 pgs.
The fee has been calculated as shown below in the 'Claims as Filed' table.
- ☒ 13 sheets of informal drawings
- ☒ A signed Combined Declaration and Power of Attorney
- ☒ Assignment of the invention to Microsoft Corporation, Recordation Form Cover Sheet
- ☒ A check in the amount of \$1246.00 to cover the Filing Fee
- ☒ A check for \$40.00 to cover the Assignment Recording Fee.
- ☒ Return postcard

CLAIMS AS FILED

| Number of Claims Filed | | In Excess of: | | Number Extra | | Rate | | Fee |
|------------------------------|---|---------------|---|--------------|---|-------|---|-----------|
| Basic Filing Fee | | | | | | | | \$710.00 |
| Total Claims | | | | | | | | |
| 32 | - | 20 | = | 12 | x | 18.00 | = | \$216.00 |
| Independent Claims | | | | | | | | |
| 7 | - | 3 | = | 4 | x | 80.00 | = | \$320.00 |
| MULTIPLE DEPENDENT CLAIM FEE | | | | | | | | \$0.00 |
| TOTAL FILING FEE | | | | | | | | \$1246.00 |

Please charge any additional fees or credit overpayment to Deposit Account No. 13-2725. A duplicate of this sheet is enclosed.

MERCHANT & GOULD P.C.
P.O. Box 2903, Minneapolis, MN 55402-0903
(303) 357-1657

By: 
Name: Ida Tuchman
Reg. No.: 45,924
Initials: IT/js



(PTO TRANSMITTAL - NEW FILING)